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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/457,842	12/09/1999	SATORU SAWADA	12924(JA998-	8134
7590	11/17/2004		EXAMINER	
SCULLY SCOTT MURPHY & PRESSER 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			SHERR, CRISTINA O	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/457,842	SAWADA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	<i>NW</i>
	Cristina Owen Sherr	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 July 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8, 10-16 and 21-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-8, 10-16 and 21-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This communication is in response to the Applicant's Amendment filed July 23, 2004. Claims 1-3, 10 and 13 have been amended. Claims 9 and 17-20 have been canceled. Claim 24 is newly added. Claims 1-8, 10-16 and 21-24 are pending in this case.

### ***Response to Arguments***

2. Applicant's arguments filed July 23, 2004 have been fully considered but they are not persuasive.

3. Applicant argues, with respect to claims 1-8, 10-16, and 21-23 That Downs does not disclose charging for downloaded data. Attention is directed to Downs (US 6,226,618131) at, e.g., col 8 ln 7-15, col 3 ln 40-56, col 7 ln 40-55. Applicant further argues that Downs does not disclose or suggest a recording medium that includes both recognition data that is used to identify the type of data downloaded and charging data relating to paying for the downloaded data. Attention is directed to Downs (US 6,226,618131) at, e.g., col 7 ln 56-col 8 ln 5.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 21, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

6. Regarding claim 1 -

Downs discloses a data charging system for charging for the use of object data, the system comprising: a content generator for generating contents containing object data of a specific type, a charge recording medium for recording charging data used for paying for said object data and recognition data used for identifying the specific type of the object data in said contents, and a data charging apparatus for charging for the use of said object data by using said charging data and said recognition data which have been recorded; wherein said data charging apparatus comprises: data reading logic for reading out said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, a recognition logic for identifying the specific type of said separated object data by using said recognition data which has been read out from the recording medium, an accounting logic for dynamically charging for the use of said separated object data, based on the specific type of data said separated object data is, and by using said charging data which has been read out from the recording medium, and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 8 ln 7-15, col 3 ln 40-56, col 7 ln 40-55).

7. Regarding claim 21 -

Downs discloses a data charging system according to claim 20, wherein the content generator generates watermark information about the digital watermark and also embedded in said contents (e.g. col 7 ln 56-col 8 ln 5).

8. Regarding claim 24 –

Downs discloses a data charging system according to claim 1, wherein: the content generator also puts recognition data in said contents; and the object data is identified based on the recognition data in said contents and said recognition data read from the recording medium (e.g. col 3 ln 40-56).

9. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

Downs discloses a content generator for embedding digital watermarks in object data of a specific type and generating contents in a data charging system which records, on a charge recording medium, the charging data used for paying for object data contained in said contents and the recognition data used for identifying the specific type of the object data in said contents and charges only for the use of the object data embedded with said digital watermarks, based on the specific type of data said object data is, and, by using said charging data and said recognition data recorded (e.g. col 7 ln 56-col 8 ln 5).

10. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

11. Regarding claim 3-

Downs discloses a data charging system which records, on a charge recording medium, the charging data used for charging for object data of a specific type and contained in said contents and the recognition data used for identifying the specific type of the object data in said contents charges for the use of said object data by using said charging data and said recognition data recorded, a data charging apparatus comprising: a data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, a recognition logic for identifying the specific type of said separated object data by using said recognition data read out, an accounting logic for charging for the use of said separated object, based on the specific type of data said separated object data is, and data by using said charging data read out, and a writing logic for writing, as part of said charging data in the recording medium, the results of charging for the use of said separated object data (e.g. col 11 ln 1-28).

12. Regarding claim 4 -

Downs discloses the data charging apparatus according to Claim 3, wherein said contents comprise said object data and said recognition data for recognizing this object data, said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charges for said object data by using said charging data read out (e.g. col 7 ln 56-col 8 ln 5).

13. Regarding claim 5 -

Downs discloses the data charging apparatus according to Claim 3, further comprising a watermarking logic for embedding digital watermarks in said object data separated from said contents, wherein said separator separates said object data and said recognition data from said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charges for said object data embedded with said digital watermarks (e.g. col 7 ln 40-65).

14. Regarding claim 6 -

Downs discloses the data charging apparatus according to Claim 3, wherein a digital watermark is embedded in said object data in said contents, said data charging apparatus further comprising a means for detecting if said object data is embedded with said digital watermark, said separator separating said object data and said recognition data from said contents, said recognition logic recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charging for said object data only if said object data is found to be embedded with said digital watermark (e.g. col 7 ln 56-col 8 ln 5).

15. Regarding claim 7 -

Downs discloses the data charging apparatus according to Claim 3, wherein said charging data recorded on said recording medium contains at least payment data which indicates the payment made in advance for the use of said object data, and said

accounting logic charges for the use of said object data within the limits of the amount indicated by said payment data contained in said charging data (e.g. col 8 ln 6-15).

16. Regarding claim 8 -

Downs discloses the data charging apparatus according to Claim 7, wherein said charging data recorded on said recording medium further contains unit price data representing the accounting unit for the use of said object data and the price corresponding to the accounting unit, said data charging apparatus comprising an accounting unit detection logic for detecting unit accounting amount data which represents the amount of said accounting unit for the object data separated from said contents, said accounting logic charging within the limits of the amount indicated by said payment data, based on said unit price data contained in said charging data read out and on the unit accounting amount data detected (e.g. col 11 ln 15-28).

17. Claims 10-12 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

18. Regarding claim 10 -

Downs discloses a data charging method for generating contents which contain object data of a specific type and recognition data used for the identification of the specific type of this object data in the generated contents, recording, in a charge recording medium, the charging data used for charging for said object data and the recognition data used for identifying the specified type of the object data, and charging for the use of said object data by using said charging data and said recognition data recorded, comprising the steps of reading said recognition data and said charging data from said recording

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medium, separating said object data from said contents, identifying the specified type of said separated object data by using said recognition data read out, dynamically charging for the use of said separated object data, based on the specific type of data said object data is, and by using said charging data read out from the recording medium; and writing into the recording medium, as part of said charging data, the results of charging for the use of said recognized object data (e.g. col 10 ln 50 - col 11 ln 28).

19. Regarding claim 11 -

Downs discloses a data charging method according to Claim 10, wherein said object data in said contents are embedded with digital watermarks, comprising the steps of separating said object data and said recognition data from said contents; recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; detecting said digital watermark embedded in said object data; and charging for said recognized object data only by using said charging data read out if said object data is found to be embedded with said digital watermark (e.g. col 7 ln 56-col 8 ln 5).

20. Regarding claim 12 -

Downs discloses a data charging method according to Claim 10, comprising the steps of separating said object data and said recognition data from said contents recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; embedding digital watermarks in said separated object data; and charging for the use of the object data

embedded with said digital watermarks by using said charging data read out (e.g. col 7 In 56-col 8 In 5).

21. Regarding claim 22 -

Downs discloses a method according to claim 11 further comprising the step of embedding in said contents information about the digital watermark (e.g. col 8 In 1-5)

22. Regarding claim 23 -

Downs discloses a method according to claim 22 wherein the embedding step includes the step of embedding in said contents instructions for embedding the contents with said digital watermarks (e.g. col 7 In 56-col 8 In 5).

23. Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618131).

24. Regarding claim 13 -

Downs discloses a data charging apparatus of a data charging system which records, on a charge recording medium, the charging data used for charging for the object data of a specified type and contained in contents and the recognition data used for identifying the specified type of the object data in said contents, and charges for the use of said object data by using said charging data and said recognition data recorded; a computer program product enabling a computer to execute the steps of reading said recognition data and said charging data from the recording medium, separating said object data from said contents, identifying the specified type of said separated object data by using said recognition data read out, dynamically charging for the use of said separated object data, based on the specific type of data said separated object data is,

and by using said charging data read out from the recording medium, and writing into the recording medium, as part of said charging data, the results of charging for the use of said recognized object data into said recording medium (e.g. col 11 In 1-28).

25. Regarding claim 14 -

Downs discloses the computer program product according to Claim 13, wherein said contents contain said object data and said recognition data used for recognition of the object data, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step by using said charging data read out (e.g. col 11 In 1-28).

26. Regarding claim 15 -

Downs discloses the computer program product according to Claim 13, wherein the computer is made to execute the step of embedding digital watermarks in said object data separated from said contents, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data embedded with said digital watermarks in said charging step (e.g. col 7 In 56-col 8 In 5).

27. Regarding claim 16 -

Downs discloses the computer program product according to Claim 13, wherein said

object data in said contents are embedded with digital watermarks, the computer is further made to execute the step of detecting that said object data is embedded with said digital watermarks, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step only if said object data is found to be embedded with said digital watermark (e.g. col 7 In 56-col 8 In 5).

28. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

29. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

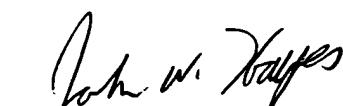
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN W. HAYES  
PRIMARY EXAMINER